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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/875,707	06/05/2001	Dan Kikinis	ISURFTV137	7928
52940 7590 06/13/2007 HOLLAND & KNIGHT LLP Attn: Stefan Stein/IP Dept 131 S. DEARBORN STREET 30TH FLOOR CHICAGO, IL 60603			EXAMINER SALTARELLI, DOMINIC D	
			ART UNIT 2623	PAPER NUMBER
			MAIL DATE 06/13/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/875,707	Applicant(s) KIKINIS ET AL.	
	Examiner Dominic D. Saltarelli	Art Unit 2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 4, 2007 has been entered.

Response to Arguments

2. Applicant's arguments filed April 4, 2007 have been fully considered but they are not persuasive.

Applicant argues that the combination of Wharton, Terkado, and Stautner fail to disclose the amended limitation of selective programming of an EPG by one of said hand-held devices, which selective programming of said one hand-held device is then communicated to one or more of the other said hand-held devices (applicant's remarks, page 7).

In response, the primary reference, Wharton, teaches that the actions of an individual hand held device are communicated to all other involved hand held devices (Wharton, col. 4, lines 15-30). Thus, when a user performs a programming operation (any operation which changes the state of the application in use) on a program guide using their hand-held device (such as selecting a program or interactive feature), this programming operation is communicated to

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the other hand-held devices, as per the disclosure of Wharton, who teaches keeping the devices coordinated.

Also, the applicant did not traverse the official notice taken that it is notoriously well known in the art to change the colors of a displayed background in order to draw a viewer's attention to an object or occurrence of interest, which is taken as an admission of the facts herein as per MPEP 2144.03.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wharton et al. (5,831,664) [Wharton] in view of Terkado et al. (6,311,329) [Terakado] and Stautner et al. (6,172,677) [Stautner].

Regarding claims 1, 9, and 17, Wharton discloses an entertainment system (figs. 1 and 2) comprising:

a unit to transmit information and to receiving information via a wireless connection (figs. 1 and 2, settop box 16);

a plurality of hand held devices capable of simultaneously communicating with said unit (PDAs 12 shown in fig. 2), wherein each apparatus comprises a

control unit to interact with an application that is selectively programmed by one of said hand held devices (col. 1 line 60 – col. 2 line 10 and col. 3 line 25 – col. 4 line 36), which selective programming of said one hand held device is then communicated to the other hand held devices (col. 4, lines 15-30).

Wharton fails to disclose the application is an electronic program guide (EPG) and an indicator to indicate availability of an interactive function in a program corresponding to the EPG.

In an analogous art, Terakado teaches it was well known to use handheld devices to conveniently view program guide information (col. 5, lines 46-57).

It would have been obvious at the time to a person of ordinary skill in the art to modify the system disclosed by Wharton to use the handheld devices to view an EPG. The suggestion to do so is found in Wharton, col. 1, lines 27-59, who teaches, when describing the problem his invention address, the limitations of current television applications is due largely to the limitations of the remote control devices used by viewers, and foremost of television applications is the EPG.

Wharton and Terakado fail to disclose an indicator to indicate availability of an interactive function in a program corresponding to the EPG.

In an analogous art, Stautner teaches an EPG that includes indicators to indicate availability of interactive functions in programs corresponding to the EPG (fig. 2), providing an enhanced EPG with improved flexibility in providing access to information to users (col. 3 line 30 – col. 4 line 9).

It would have been obvious at the time to a person of ordinary skill in the art to modify the system disclosed by Wharton and Terakado to include an indicator to indicate availability of an interactive function in a program corresponding to the EPG, as taught by Stautner, for the benefit of providing an enhanced EPG with improved flexibility in providing access to information to users.

Regarding claims 2, 10, and 18, Wharton, Terakado, and Stautner disclose the system of claims 1, 9, and 17, wherein the indicator is displayed on a display of the apparatus (screen of the PDA, see Wharton, figs. 3a-f).

Regarding claims 3, 4, 7, 11, 12, 15, 19, 20, and 23, Wharton, Terakado, and Stautner disclose the system of claims 1, 2, 9, 10, 17, and 18, but fail to disclose the display changes background colors (flashes) or generates a sound to indicate the availability of the interactive function in the program corresponding to the EPG.

Examiner takes official notice that it is notoriously well known in the art to change the colors of a displayed background in order to draw a viewer's attention to an object or occurrence of interest.

It would have been obvious at the time to a person of ordinary skill in the art to modify the system disclosed by Wharton, Terakado, and Stautner to include the display changes background colors or generates a sound, such as a

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beep or chime, to indicate the availability of the interactive function in the program corresponding to the EPG, as these is a conventional method used draw a viewer's attention.

Regarding claims 5, 13, and 21, Wharton, Terakado, and Stautner disclose the system of claims 1, 9, and 17, wherein the apparatus is a personal digital assistant (Wharton, fig. 1, PDA 12).

Regarding claims 6, 14, and 22, Wharton, Terakado, and Stautner disclose the system of claims 1, 9, and 17, wherein the apparatus is a web phone (Wharton teaches the PDA is an Apple Newton, col. 3, lines 26-54, a device capable of both telephonic communications and Internet access).

Regarding claims 8, 16, and 24, Wharton, Terekado, and Stautner disclose the system of claims 1, 9, and 17, wherein the indicator is a section of the apparatus that illuminates to indicate the availability of the interactive function in the program corresponding to the EPG (displayed icons are illuminated sections of a display, Stautner, col. 6, lines 8-24).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dominic D. Saltarelli whose telephone number is (571)

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272-7302. The examiner can normally be reached on Monday - Friday 9:00am - 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DS


ANDREW Y. KOENIG
PRIMARY PATENT EXAMINER